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OFFICE OF PETITIONS

BIOGEN IDEC / FINNEGAN HENDERSON, LLP
901 NEW YORK AVENUE, NW
WASHINGTON DC 20001-4413

In re Application of	:	
Browning et al.	:	DECISION ON APPLICATION
Application No. 10/077,137	:	FOR
Filed: February 15, 2002	:	PATENT TERM ADJUSTMENT
Atty Docket No. 08201.0027-00000	:	

This is in response to the APPLICATION FOR PATENT TERM ADJUSTMENT - PRE-GRANT filed July 10, 2009. Applicants requests that the determination of patent term adjustment be corrected from two hundred fifty-three (253) days to eight hundred fifty-five (855) days. Applicants request this correction, in part, on the basis that the Office will take in excess of three years to issue this patent.

To the extent the instant application for patent term adjustment requests reconsideration of the patent term adjustment as it relates to the Office's failure to issue the patent within three years of the filing date, the application for patent term adjustment under 37 CFR 1.705(b) is **DISMISSED as PREMATURE**.

Knowledge of the actual date the patent issues is required to calculate the amount, if any, of additional patent term patentee is entitled to for Office failure to issue the patent within 3 years. See § 1.702(b). (This is true even where a request for continued examination (RCE) was filed). The computer will not undertake the § 1.702(b) calculation until the actual date of issuance of the patent has been determined. Likewise, the computer will not calculate any further Office delay under § 1.702(a)(4) or applicant delay under § 1.704(c)(10) until the actual date of issuance of the patent has been determined. As such, the Office can not make a determination on the correctness of the patent term adjustment until the patent has issued.

Requesting reconsideration of the patent term adjustment to be indicated on the patent under 37 CFR 1.705(b) based on the initial determination of patent term adjustment and a projected issuance date of the patent (or even the filing date of the request for continued examination) is premature. Accordingly, it is appropriate to dismiss as premature such a request.

Rather than file an application for patent term adjustment under 37 CFR 1.705(b) contesting the 37 CFR 1.702(b) calculation at the time of the mailing of the notice of allowance, applicants are advised that they may wait until the time of the issuance of the patent and file a request for reconsideration of the patent term adjustment pursuant to 37 CFR 1.705(d). As the USPTO does not calculate the amount of time earned pursuant to 37 CFR 1.702(b) until the time of the issuance of the patent, the Office will consider any request for reconsideration of the patent term adjustment due to an error in the calculation of 37 CFR 1.702(b) to be timely if the request for reconsideration is filed within two months of the issuance of the patent.

However, as to all other bases for contesting the initial determination of patent term adjustment received with the notice of allowance, applicant must timely file an application for patent term adjustment prior to the payment of the issue fee¹.

To the extent that the instant application for patent term adjustment requests reconsideration of the patent term adjustment at the time of the mailing of the Notice of Allowance, the request is **GRANTED TO THE EXTENT INDICATED.**

The Office has updated the PALM and PAIR screens to reflect that the Patent Term Adjustment (PTA) determination at the time of the mailing of the Notice of Allowance is **three hundred seventy-two (372) days**. A copy of the updated PALM screen is enclosed.

¹ For example, if applicant disputes both the calculation of patent term adjustment under 37 CFR 1.702(a)(1) for Office failure to mail a first Office action or notice of allowance not later than fourteen months after the date on which the application was filed and under 37 CFR 1.702(b) for Office failure to issue a patent within three years of the actual filing date of the application, then applicant must still timely file an application for patent term adjustment prior to the payment of the issue fee to contest the calculation of Office delay in issuing a first Office action or notice of allowance. See 37 CFR 1.705(b) and 35 U.S.C. 154(b)(3)(B). A dispute as to the calculation of the § 1.702(a)(1) period raised on request for reconsideration of patent term adjustment under 37 CFR 1.705(d) will be dismissed as untimely filed.

On April 13, 2009, the Office mailed a Determination of Patent Term Adjustment under 35 U.S.C. 154(b) in the above-identified application. The Notice stated that the patent term adjustment to date was 253 days. The instant application for patent term adjustment was timely filed.² Applicants state that no terminal disclaimer has been filed.

Applicants dispute the period of reduction of 110 days³ for the filing of the REPLY TO OFFICE ACTION on November 7, 2005. Applicants assert that the reply to the non-final Office action on July 20, 2005, was fully responsive and complete. Accordingly, applicants assert that the reduction of 110 days is not warranted. Moreover, applicants aver that a period of adjustment of 86 days pursuant to 37 CFR 1.702(a)(2) should be entered for the period from November 21, 2005, the day after the date that is four months after the reply was filed on July 20, 2005, to February 14, 2006, the date of the mailing of the final Office action.

The Office has considered applicants' arguments and finds them persuasive to an extent. 37 CFR 1.704(c)(7) provides:

Submission of a reply having an omission (§ 1.135(c)), in which case the period of adjustment set forth in § 1.703 shall be reduced by the number of days, if any, beginning on the day after the date the reply having an omission was filed and ending on the date that the reply or other paper correcting the omission was filed.

The record supports a conclusion that the reply filed July 20, 2005, did not contain an omission. On November 7, 2005, in response to the Office communication mailed October 7, 2005, applicants noted that missing attachments 6-11 were present in the Image File Wrapper under Foreign Reference (mail room date July 20, 2005) at pages 46-65, and thus, requested the Office communication be withdrawn. Applicants further noted that they had spoken with the examiner and that she had acknowledged that the reply of July 20, 2005, as originally filed, was complete. As the examiner entered the response and amendment filed on July 20, 2005, the showing of record is that the examiner determined

² PALM records indicate that the issue fee was paid on July 10, 2009.

³ It is noted that the basis for entry of the period of reduction of 110 days is 37 CFR 1.704(c)(7), not 1.704(c)(8) as indicated by applicants.

that the reply was fully responsive. As the reply of July 20, 2005, did not have an omission, the period of reduction of 110 days, pursuant to 37 CFR 1.704(c)(7), is unwarranted and will be removed.

It is noted that in response to the reply filed July 20, 2005, the Office took action within the meaning of 37 CFR 1.702(a)(2) and 1.703(a)(2) on October 7, 2005, within four months of the date the reply was filed. No further correction of the patent term adjustment calculation is required. In response to the reply filed November 7, 2005, the Office took action within the meaning of 37 CFR 1.702(a)(2) and 1.703(a)(2), within four months by mailing an action under 35 U.S.C. 132 on February 14, 2006. The fact that the Office mailed a final Office action on February 14, 2006, does not negate the fact that the Office took action within the meaning of 35 U.S.C. 132 on October 7, 2005. Accordingly, a period of adjustment of 86 days for examination delay is not merited.

Next, applicants assert that the period of reduction pursuant to 37 CFR 1.704(b) for the filing of a reply on March 28, 2007, should be 89 days, not 98 days. Applicants' assertion is well taken.

On September 20, 2006, the Office mailed a non-final Office action. On September 29, 2006, the Office re-mailed the non-final Office action and reset the period for response as of the date of the re-mailing of the non-final Office action because the Office action was mailed under an inappropriate cover sheet.

Under the circumstances, it is appropriate to use the re-mailing date of the non-final Office action on September 29, 2006, for purposes of calculating any reduction of patent term adjustment under 37 CFR 1.704(b).

On March 28, 2007, applicants submitted a response three months and 89 days after the date of the mailing of the non-final Office action as re-mailed on September 29, 2006. Accordingly, the period of reduction of 98 days is being removed and the period of reduction of 89 days is being entered.

In view thereof, the determination of patent term adjustment at the time of the mailing of the Notice of Allowance is 372 days (606 days of Office delay less 234 days of applicant delay).

The Office acknowledges the submission of the \$200.00 fee set forth in 37 CFR 1.18(e). No additional fees are required.

Applicants are reminded that any delays by the Office pursuant to 37 CFR 1.702(a)(4) and 1.702(b) and any applicant delays under 37 CFR 1.704(c)(10) will be calculated at the time of the issuance of the patent and applicants will be notified of the revised patent term adjustment to be indicated on the patent in the Issue Notification letter that is mailed to applicants approximately three weeks prior to issuance.

The Office of Data Management has been advised of this decision. This matter is being referred to the Office of Data Management for issuance of the patent.

Telephone inquiries specific to this matter should be directed to the undersigned at (571) 272-3211.

Christina Tartera Donnell

Christina Tartera Donnell
Senior Petitions Attorney
Office of Petitions

Enclosure: Copy of updated PALM screen

Day : Wednesday

PALM INTRANET

Date: 2/3/2010

Time: 14:31:16

PTA Calculations for Application: 10/077137

Application Filing Date:	02/15/2002	PTO Delay (PTO):	606
Issue Date of Patent:		Three Years:	0
Pre-Issue Petitions:	0	Applicant Delay (APPL):	353
Post-Issue Petitions:	0	Total PTA (days):	372
PTO Delay Adjustment:	119		

File Contents History

Number	Date	Contents Description	PTO	APPL	START
118	02/03/2010	ADJUSTMENT OF PTA CALCULATION BY PTO		89	
117	02/03/2010	ADJUSTMENT OF PTA CALCULATION BY PTO	98		
116	02/03/2010	ADJUSTMENT OF PTA CALCULATION BY PTO	110		
102	04/13/2009	MAIL NOTICE OF ALLOWANCE			
101	04/08/2009	ISSUE REVISION COMPLETED			
100	04/08/2009	DOCUMENT VERIFICATION			
99	04/08/2009	CASE DOCKETED TO EXAMINER IN GAU			
90	04/08/2009	NOTICE OF ALLOWANCE DATA VERIFICATION COMPLETED			
89	04/08/2009	CASE DOCKETED TO EXAMINER IN GAU			
88	04/08/2009	NOTICE OF ALLOWABILITY			
85	03/27/2009	DATE FORWARDED TO EXAMINER			
84	03/26/2009	AMENDMENT AFTER FINAL REJECTION			
83	12/31/2008	MAIL FINAL REJECTION (PTOL - 326)			
82	12/31/2008	FINAL REJECTION			
79	10/21/2008	DATE FORWARDED TO EXAMINER			
78	09/17/2008	RESPONSE AFTER NON-FINAL ACTION		34	76
77	09/17/2008	REQUEST FOR EXTENSION OF TIME - GRANTED			
76	05/14/2008	MAIL NON-FINAL REJECTION	75		68
75	05/12/2008	NON-FINAL REJECTION			
71	11/27/2007	DATE FORWARDED TO EXAMINER			
70	10/31/2007	AMENDMENT SUBMITTED/ENTERED WITH FILING OF CPA/RCE			
69	11/27/2007	DATE FORWARDED TO EXAMINER			
68	10/31/2007	REQUEST FOR CONTINUED EXAMINATION (RCE)		47	64

67	11/27/2007	DISPOSAL FOR A RCE / CPA / R129			
66	10/31/2007	REQUEST FOR EXTENSION OF TIME - GRANTED			
65	10/31/2007	WORKFLOW - REQUEST FOR RCE - BEGIN			
64	06/14/2007	MAIL FINAL REJECTION (PTOL - 326)			
63	06/11/2007	FINAL REJECTION			
62	03/28/2007	AFFIDAVIT(S) (RULE 131 OR 132) OR EXHIBIT(S) RECEIVED			
61	04/04/2007	DATE FORWARDED TO EXAMINER			
60	03/28/2007	RESPONSE AFTER NON-FINAL ACTION		98	55
59	03/28/2007	REQUEST FOR EXTENSION OF TIME - GRANTED			
58	11/20/2006	CORRESPONDENCE ADDRESS CHANGE			
57	09/29/2006	MAIL NOTICE OF RESTARTED RESPONSE PERIOD			
56	09/27/2006	LETTER RESTARTING PERIOD FOR RESPONSE (I.E. LETTER RE: REFERENCES)			
55	09/20/2006	MAIL NON-FINAL REJECTION			
54	09/05/2006	NON-FINAL REJECTION			
53	06/14/2006	INFORMATION DISCLOSURE STATEMENT CONSIDERED			
52	06/14/2006	REFERENCE CAPTURE ON IDS			
51.7	06/14/2006	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
51	06/14/2006	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
50	06/27/2006	DATE FORWARDED TO EXAMINER			
49	06/14/2006	AMENDMENT SUBMITTED/ENTERED WITH FILING OF CPA/RCE			
48	06/27/2006	DATE FORWARDED TO EXAMINER			
47	06/14/2006	REQUEST FOR CONTINUED EXAMINATION (RCE)		31	43
46	06/27/2006	DISPOSAL FOR A RCE / CPA / R129			
45	06/22/2006	CRF IS GOOD TECHNICALLY / ENTERED INTO DATABASE			
44	06/14/2006	WORKFLOW - REQUEST FOR RCE - BEGIN			
43	02/14/2006	MAIL FINAL REJECTION (PTOL - 326)			
42	02/06/2006	FINAL REJECTION			
41	11/22/2005	DATE FORWARDED TO EXAMINER			
40	11/07/2005	RESPONSE AFTER NON-FINAL ACTION		110	35

39	10/07/2005	MAIL NOTICE OF INFORMAL OR NON-RESPONSIVE AMENDMENT			
38.7	07/20/2005	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
38	07/20/2005	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
37	07/20/2005	OATH OR DECLARATION FILED (INCLUDING SUPPLEMENTAL)			
36	07/26/2005	DATE FORWARDED TO EXAMINER			
35.1	07/20/2005	INFORMAL OR NON-RESPONSIVE AMENDMENT AFTER EXAMINER ACTION			
35	07/20/2005	RESPONSE AFTER NON-FINAL ACTION		33	32
34	07/20/2005	REQUEST FOR EXTENSION OF TIME - GRANTED			
33	04/08/2005	CORRESPONDENCE ADDRESS CHANGE			
32	03/17/2005	MAIL NON-FINAL REJECTION			
31	03/07/2005	NON-FINAL REJECTION			
30	01/05/2005	DATE FORWARDED TO EXAMINER			
29	12/17/2004	RESPONSE TO ELECTION / RESTRICTION FILED			
28	12/17/2004	REQUEST FOR EXTENSION OF TIME - GRANTED			
27	12/17/2004	WORKFLOW INCOMING AMENDMENT IFW			
26	09/27/2004	MAIL RESTRICTION REQUIREMENT	531		-1
25	09/24/2004	REQUIREMENT FOR RESTRICTION / ELECTION			
24	07/13/2004	REFERENCE CAPTURE ON IDS			
23.7	07/13/2004	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
23	07/13/2004	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
19	06/28/2004	CASE DOCKETED TO EXAMINER IN GAU			
18	04/06/2004	CASE DOCKETED TO EXAMINER IN GAU			
17	07/10/2003	IFW TSS PROCESSING BY TECH CENTER COMPLETE			
16	07/10/2003	IFW TSS PROCESSING BY TECH CENTER COMPLETE			
15.7	11/18/2002	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
15	11/18/2002	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
14	02/12/2003	CORRESPONDENCE ADDRESS CHANGE			
13	06/12/2002	CASE DOCKETED TO EXAMINER IN GAU			

12	06/04/2002	APPLICATION DISPATCHED FROM OIPE			
11	05/31/2002	APPLICATION IS NOW COMPLETE			
8	05/15/2002	ADDITIONAL APPLICATION FILING FEES			
7	05/15/2002	A STATEMENT BY ONE OR MORE INVENTORS SATISFYING THE REQUIREMENT UNDER 35 USC 115, OATH OF THE APPLIC			
6	03/15/2002	NOTICE MAILED--APPLICATION INCOMPLETE-- FILING DATE ASSIGNED			
5	03/14/2002	CRF IS GOOD TECHNICALLY / ENTERED INTO DATABASE			
4	03/01/2002	IFW SCAN & PACR AUTO SECURITY REVIEW			
3	02/15/2002	CRF DISK HAS BEEN RECEIVED BY PREEXAM / GROUP / PCT			
2	02/15/2002	INITIAL EXAM TEAM NN			

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EXPLANATION OF PTA CALCULATION

EXPLANATION OF PTE CALCULATION

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